

## REMARKS

This application has been reviewed in light of the Office Action dated December 14, 2004. Claims 1, 58 and 60 to 68 are in the application, of which Claims 67 and 68 have been newly-added. Claims 1, 58, 61, 62, 64, 65 and 68 are the independent claims herein. Reconsideration and further examination are respectfully requested.

Applicants acknowledge the restriction requirement between Claims 1, 58 and 60 (Group I) and Claims 61 to 66, as well as the Examiner's indication of a constructive election of the Group I claims. However, Applicants wholly disagree with the basis for the restriction and therefore, the restriction requirement is hereby traversed.

In this regard, the Office Action indicated that restriction was considered proper because "the process as claimed can be practiced by another materially different apparatus--an apparatus that does not include a receiver." However, Applicant fails to see how the process of either Claims 1 or 58, both of which include a receiving step, could possibly be performed by another *materially different* apparatus that does not include a receiver. Inasmuch as the process claims require a receiving step (to receive participating information in Claim 1, or to receive user log-in information in Claim 58), any apparatus that performs the claimed process would necessarily have to have some type of receiver to receive the claimed information. Accordingly, the basis for the restriction is illogical and facially defective.

Moreover, traversal is on the ground that there would not be an undue burden on the Examiner to examine all of the claims in a single application. In particular, MPEP § 808 makes it clear that in order to require restriction between allegedly independent or distinct inventions, reasons for insisting upon a restriction requirement, such as undue burden, must also

be shown. In the present case, Claim 61 is directed to a computer-readable storage medium which stores computer program code to execute the method precisely as claimed in Claim 1. Likewise, Claim 64 is directed to an information processing apparatus that executes the method and/or computer program code of Claims 1 and 61. Thus, inasmuch as it is abundantly clear that the method of Claim 1 is performed by an information processing apparatus, which necessarily entails the execution of computer code, a search of prior art for Claim 1 would necessarily encompass the needs for examining Claims 61 and 64, particularly since each of those claims substantially read on one another. Thus, Applicants fail to see how examining all of Claims 1, 61 and 64 in the same application could possibly present an undue burden on the Examiner.

The same analysis applies with equal force to the restriction of Claims 58, 62 and 65.

In view of the foregoing, reconsideration and withdrawal of the restriction requirement are respectfully requested, and rejoinder of Claims 61 to 66 and an action on the merits for all pending claims is respectfully solicited.

Claims 1 and 58 were rejected under 35 U.S.C. § 112, second paragraph. While Applicants believe the claims are clear on their face, and that those skilled in the art would understand the subject matter of the claims, the claims have nonetheless been made even clearer by rephrasing the terminology in question. Thus, reconsideration and withdrawal of the § 112, rejections are respectfully requested.

Claims 1, 58 and 60 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,629,134 (Hayward), and Claims 1, 58 and 60 were alternatively rejected under 35 U.S.C. § 103(a) over Hayward. Claims 1, 58 and 60 were also rejected under 35 U.S.C. § 102(e) over

U.S. Patent No. 6,295,423 (Haines), and under § 102(e) over U.S. Patent No. 6,233,408 (Allen).

The rejections are traversed and the Examiner is requested to reconsider and withdraw the rejections in light of the following comments.

The present invention concerns the return of used consumables by a user.

According to one aspect of the invention, an apparatus (e.g., a server) that manages the return of used consumables receives participating information from a terminal of a user indicating whether or not the user wants to participate in a return service that allows the user to return the used consumable. Based on the received participating information, a flag is set in a memory of the apparatus. The server transmits information to the user's terminal for the user to input an order for a new consumable and to specify the return of the used consumable. The server also transmits a message to the user's terminal, where the transmitted message is based on the flag such that, if the flag indicates that the user does not wish to participate in the return service, the message prompts the user about the service, but if the flag indicates that the user does wish to participate, history regarding the return and an incentive point corresponding to the history is included in the message.

As a result, the user can sign-up to participate in a return service to return used consumables (e.g., used ink cartridges) to a manufacturer and can receive a discount (i.e., incentive point) for returning the used consumable.

With specific reference to the claims, amended independent Claim 1 is a processing method of ordering a new consumable to be used by a printer and returning a used consumable, used by the printer, being performed by an information processing system capable of communicating with a plurality of terminals via the Internet, the method comprising the steps

of receiving participating information, indicating whether or not a user wishes to participate in a return service, from at least one terminal of the plurality of terminals, wherein the return service is provided by the system to allow the user to return the used consumable, setting a flag, which is managed by the information processing system, in a memory unit in accordance with the participating information, transmitting first information containing data fields to at least one of the plurality of terminals for display on a screen, and allowing the user to input data into the data fields to order the new consumable and to specify the return of the used consumable, and transmitting second information for display on the screen of at least one of the plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case where the flag set in the setting step indicates that the user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case where the flag set in the setting step indicates that the user wishes to participate in the return service.

Amended independent Claims 61 and 64 are computer-readable medium and apparatus claims, respectively, that substantially correspond to Claim 1.

The applied art is not seen to disclose or to suggest the features of Claims 1, 61 and 64. Specifically, the applied art is not seen to disclose or to suggest anything with regard to a service that allows a user to return a used consumable to the manufacturer, much less that an information processing apparatus in such a system receives participating information, indicating whether or not a user wishes to participate in a return service provided to allow the user to return the used consumable. Accordingly, the applied art also cannot set a flag in a memory unit in accordance with the participating information, or transmit second information for display on the

screen of at least one of a plurality of terminals, which includes a message (a) to prompt the user concerning the return service in a case where the flag set in the setting step indicates that the user did not wish to participate in the return service, and (b) indicating a history regarding the return of the used consumable by the user and an incentive point corresponding to the history in a case where the flag set in the setting step indicates that the user wishes to participate in the return service.

Hayward is merely seen to disclose that, when a user buys a new device (e.g., a multifunction device), the user can register the device with the manufacturer so that they can obtain product support via the Internet. When, for example, an ink cartridge is low on ink, the user may be warned about the low ink level via a screen as shown in Fig. 4. If the ink level is low, the user can select a “buy now” option, whereby a link to a server is established and an order screen is downloaded to the user for them to order a new ink cartridge. Alternatively, if the user already has a new ink cartridge on-hand, they can select a “show me” button, whereby instructions are downloaded to the user’s computer to inform the user of how to replace the ink cartridge in the printer. Thus, while Hayward may provide the ability to order a new ink cartridge, Applicants fail to see anything, either inherently or explicitly, in Hayward that provides a return service for the user to return the used ink cartridge to the manufacturer.

In this regard, the Office Action makes a bald assertion that Hayward inherently discloses such a feature, but the Office Action fails to point out any particular part of Hayward that does, or that even could, support such an assertion. The fact that a user can order a new cartridge says nothing about returning the used cartridge to the manufacturer, but rather, it can readily be assumed that the user will simply dispose of the used cartridge by throwing it in

the trash. This failure to disclose a return service is made even clearer by the fact that Hayward also fails to provide any type of discount or incentive point to the user when ordering the new ink cartridge in exchange for returning the used cartridge. In fact, the only disclosure of an incentive in Hayward is a commission provided to retailers of ink cartridges that deliver the newly-ordered cartridge to the user. (see, for example, column 8, lines 59 to 67.) Thus, Applicants fail to see how Hayward could possibly support a rejection under § 103(a), much less one under § 102(e) of Claims 1, 61 and 64.

In view of the foregoing deficiencies, amended independent Claims 1, 61 and 64, as well as the claims dependent therefrom, are believed to be allowable over Hayward.

Haines is merely seen to disclose a lifetime consumable monitoring system that provides a warning to a user when a consumable item is expended or is near being expended. However, like Hayward, Applicants fail to see anything in Haines that relates to a return service for returning the used consumable, much less determining an incentive point for returning the used consumable. Accordingly, Claims 1, 61 and 64, as well as the claims dependent therefrom, are believed to be allowable over Haines.

Allen is merely seen to disclose a system that, when a consumable is expended or is nearly expended, a certificate is provided to the user for the purchase of a new consumable. The certificate may be for a discount (e.g., a coupon) toward the purchase of a new consumable. Thus, while Allen may provide a discount for the purchase of a new consumable, Applicants fail to see where such a discount is related to returning a used consumable. Thus, Allen is not seen to disclose or to suggest the features of Claims 1, 61 and 64 and those claims, as well as the claims dependent therefrom, are believed to be allowable over Allen.

In a related aspect of the invention, the server receives user log-in information and reads history information, corresponding to the user log-in, regarding a used consumable returned by the user. Based on the read history, an incentive point is determined, and a message indicating the read history and the determined incentive point is sent to a terminal of the user. Thus, according to this aspect, when the user logs-in to order a new consumable, the user is provided with a message indicating a discount based on return of the used consumable.

Referring specifically to the claims, amended independent Claim 58 is a processing method for returning a used consumable, used by a printer, being performed by an information processing system capable of communicating with a plurality of terminals via the Internet, said method comprising the steps of receiving user log-in information from one of the plurality of terminals, reading a history, which corresponds to the user log-in information, regarding the used consumable returned by the user from a database, determining an incentive point based on the history read in said reading step, and generating a message indicating the history read in said reading step and the incentive point determined in said determining step, to be sent to one of the plurality of terminals.

Amended independent Claims 62 and 65 are computer-readable medium and apparatus claims, respectively, that substantially correspond to Claim 58.

The applied art is not seen to disclose or to suggest the features of Claims 58, 62 and 65, and in particular, is not seen to disclose or to suggest at least the feature of reading a history, which corresponds to a user log-in, regarding a used consumable returned by the user. Moreover, the applied art is not seen to disclose or to suggest determining an incentive point based on the read history, and generating a message indicating the read history and the

determined incentive point, to be sent to one of a plurality of terminals.

As discussed above, Applicants fail to see any disclosure in Hayward of a return service or providing an incentive to the user for returning the used consumable.

Accordingly, Hayward cannot read history information which corresponds to a user log-in, regarding a used consumable returned by the user, or determine an incentive point based on the read history, and generate a message indicating the read history and the determined incentive point, to be sent to one of a plurality of terminals.

Haines merely discloses warning a user when a consumable item is expended or is near being expended. However, like Hayward, Applicants fail to see anything in Haines that relates to a return service for returning the used consumable, much less determining an incentive point for returning the used consumable. Accordingly, Claims 58, 62 and 65, as well as the claims dependent therefrom, are believed to be allowable over Haines.

Allen merely discloses providing a certificate for a discount toward the purchase of a new consumable. However, Applicants fail to see where Allen provides an incentive for returning a used consumable. Thus, Allen is not seen to disclose or to suggest the features of Claims 58, 62 and 65 and those claims, as well as the claims dependent therefrom, are believed to be allowable over Allen.

In view of the foregoing deficiencies of the applied art, amended independent Claims 58, 62 and 65, as well as the claims dependent therefrom, are believed to be allowable.

Newly-added independent Claim 68 includes features along the lines of the foregoing, but is more specifically directed to a processing method for returning a used consumable, used by a printer, being performed by an information processing system capable of



communicating with a plurality of terminals via the Internet, the method comprising the steps of receiving user log-in information from one of the plurality of terminals, determining an incentive point based on a history, which corresponds to the user log-in information, regarding a used consumable returned by a user, generating a message indicating the history and the incentive point to be sent to one of the plurality of terminals, and keeping track of returning of the used consumable based on an order history and a returning history, which correspond to the user log-in information, to manage the history used in the determining step.

As discussed above, Hayward, Haines and Allen are not seen to disclose or to suggest anything with regard to providing a return service for returning a used consumable. Accordingly, newly-added Claim 68 is also believed to be allowable.

No other matters having been raised, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Attorney for Applicants

Edward A. Kmett

Registration No. 42,746

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200